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August 15, 2003

File: 3999.002383

CERTIFICATE OF MAILING 37 C.F.R. § 1.8	
I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date below:	
August 15, 2003	Shelley P.M. Fussey
Date	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RE: *U.S. Patent Application Serial No. 09/351,149; Entitled: "Cancer Treatment Kits Comprising Therapeutic Conjugates that Bind to Aminophospholipids"; by Thorpe, Ran & Brekken; Client Ref: UTSD:556--2*

Sir:

Enclosed for filing in the above-referenced patent application is:

- (1) A Request to Withdraw Premature Finality Under MPEP 706.07 and Request to Restart Period for Response Under MPEP 710.06;
- (2) A copy of previously submitted Supplemental Information Disclosure Statement submitted under 37 C.F.R. § 1.97(c) without a fee, with copy of transmittal letter and returned postcard; and
- (3) A return postcard to acknowledge receipt of these materials. Please date stamp and mail this postcard.

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WILLIAMS, MORGAN & AMERSON, P.C.

Assistant Commissioner for Patents

August 15, 2003

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No fees should be required. However, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, the Assistant Commissioner is authorized to deduct said fees from Williams, Morgan & Amerson, P.C. Deposit Account No. 50-0786/3999.002383.



23720

PATENT TRADEMARK OFFICE

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Shelley'.

Shelley P.M. Fussey, Ph.D.

Reg. No. 39,458

Patent Agent

Encls.



CERTIFICATE OF MAILING
37 C.F.R. § 1.8

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August 15, 2003

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Philip E. Thorpe, Sophia Ran and
Rolf A. Brekken (As Amended)

Group Art Unit: 1617

Serial No.: 09/351,149

Examiner: Sharareh, S.

Filed: July 12, 1999

Atty. Dkt. No.: 3999.002383

For: CANCER TREATMENT KITS
COMPRISING THERAPEUTIC
CONJUGATES THAT BIND TO
AMINOPHOSPHOLIPIDS

**REQUEST TO WITHDRAW PREMATURE FINALITY UNDER MPEP 706.07
AND REQUEST TO RESTART PERIOD FOR RESPONSE UNDER MPEP 710.06**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request that the holding of finality set forth in the originally Final Official Action dated July 15, 2003 ("the July Action") be withdrawn in accordance with MPEP 706.07(a)(d). The holding of finality is premature, as the Action entered a new ground of rejection using a reference from an Information Disclosure Statement (IDS) properly and timely submitted under 37 C.F.R. § 1.97(c) without a fee. Finality is therefore improper and should be withdrawn.

I. The July Action is Prematurely Final

Applicants filed a response to the previous Non-Final Action in the present case on April 22, 2003, after which claims 1-32 and 43-57 were pending.

On about April 28, 2003, Examiner Bahar from the present Group Art Unit (1617) telephoned Applicants' undersigned representative to discuss a co-pending U.S. application listing one of the present inventors (Serial No. 09/738,970, "the '970 application"; Attorney Docket No. 3999.000598). In a series of teleconferences beginning on about April 28, 2003, Examiner Bahar brought to Applicants attention a U.S. and European patent by Abrams.

As the teleconferences continued, Examiner Bahar evidently realized that the U.S. and European patent by Abrams were not relevant to patentability, and an Official Action was later mailed that did not cite the Abrams patents¹.

Nonetheless, as a precaution, on May 09, 2003 Applicants submitted an IDS in the present application listing the U.S. and European patents by Abrams brought to their attention by Examiner Bahar in the context of the '970 application (the IDS was received in the Office on May 13, 2003). The IDS was properly and timely submitted under 37 C.F.R. § 1.97(c) **without a fee** (copy enclosed).

Moreover, the IDS contained a certification under 37 C.F.R. § 1.97(e)(2), confirming that the listed U.S. and European patents by Abrams were not cited in a communication from a foreign patent office in a counterpart foreign application, but were cited by the examiner of the '970 application in teleconferences beginning about April 28, 2003, *i.e.*, less than three months before filing the IDS on May 09, 2003.

¹An Action was mailed on May 12, 2003, which did not include any prior art rejections.

On July 15, 2003, the Office mailed an allegedly Final Action in the present case. The July Action included a new ground of rejection under 35 U.S.C. § 103(a), citing a combination of documents including the U.S. patent by Abrams (No. 4,867,962) from Applicants' IDS. Applicants believe the rejection to be improper for a number of reasons, which is highlighted by the fact that the Abrams patents, submitted in an IDS as a precaution, was not actually cited as part of a prior art rejection¹.

As to finality, the July Action stated that "Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on May 13, 2003 prompted the new ground(s) of rejection" and therefore contended that finality was proper (July Action at page 9, emphasis added). In contrast, the IDS in question was properly submitted without a fee (copy enclosed). Finality is therefore improper (see MPEP 706.07(a) in particular) and Applicants respectfully request that the holding of finality be withdrawn. No fees are required in connection with this request.

II. Restart Period for Response

The July Action is defective in being prematurely final, as set forth above. Applicants submit that this is a defect warranting the Office to restart the period for response. Applicants therefore respectfully request that the period for response be re-started with the mailing of a non-Final Action, which corrects the earlier error of premature finality. The present Request is being filed within one month of the mail date of the Action, as required by MPEP 710.06. Restarting the period for response is therefore proper. No fees are required in connection with this request.

III. Conclusion

Finality of the July Action is premature and must be withdrawn. The period for response should also be re-set to run from the mailing of a non-Final Action.

According to MPEP 706.07(d), the present document need only be a Request and not a Petition (although Applicants reserve the right to challenge any adverse holding by petitioning the Group Director under MPEP 706.07(c) and 1002.02(c)).

No fees are due for Requests under MPEP 706.07(d) or MPEP 710.06. However, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be deemed necessary for any reason, the Commissioner is authorized to deduct said fees from Williams, Morgan & Amerson, P.C. Deposit Account No. 50-0786/3999.002383. Applicants reserve the right to request a refund for any fees deducted in connection with this Request.

Should the Office have any questions, a telephone call to the undersigned Applicants' representative is earnestly solicited.



Respectfully submitted,

A handwritten signature in black ink, appearing to be "Shelley P.M. Fussey".

Shelley P.M. Fussey, Ph.D.
Reg. No. 39,458
Agent for Applicant

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Date: August 15, 2003